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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,968	04/04/2001	Christoph Kern	P3939	4108
24739	7590	10/05/2004	EXAMINER	
CENTRAL COAST PATENT AGENCY PO BOX 187 AROMAS, CA 95004			PATEL, HARESH N	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/826,968

Applicant(s)

KERN ET AL.

Examiner

Haresh Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2001.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 25-29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/4/01 *H.P.*  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 1-14, 16-30, are presented for examination. The original numbering of the claims must be numbered consecutively. Hence, Misnumbered claims 16-30 have been renumbered as 15-29.

### *Election/Restrictions*

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, are drawn to “a software application implemented with different portions comprising a data processing portion to generate a data summary, a data caching portion for storing, managing and serving data”, 719, subclass 317.
  - II. Claims 15-24, are drawn to “a server-driven system comprising, a processing server, a cache server for accessing, obtaining and serving data to requesting users, and a user-interface server for facilitating requests from users”, classified in class 709, subclass 226.
  - III. Claims 25-29, are drawn to “creating and distributing non-sensitive data summaries by receiving and aggregating data on behalf of requesting users, identifying sensitive data portions through database comparison using a user-profile database, de-sensitizing the aggregated data, and requesting the non-sensitive data summaries to be delivered to an interface during a data session”, classified in class 707, subclass 10.
3. The inventions are distinct, each from the other because of the following reasons:

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Inventions I to III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a software application implemented with different portions comprising a data processing portion to generate a data summary, a data caching portion for storing, managing and serving data, lacking one or more of the particulars of inventions II to III. Invention II has separate utility such as a server-driven system comprising, a processing server, a cache server for accessing, obtaining and serving data to requesting users, and a user-interface server for facilitating requests from users, lacking one or more of the particulars of inventions of I and III. Invention III has separate utility such as creating and distributing non-sensitive data summaries by receiving and aggregating data on behalf of requesting users, identifying sensitive data portions through database comparison using a user-profile database, de-sensitizing the aggregated data, and requesting the non-sensitive data summaries to be delivered to an interface during a data session, one or more of the particulars of inventions of I, II. See MPEP 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the extensive search required for one group is not required for the other groups, restriction for examination purposes as indicated is proper.

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6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. A telephone call was made to Donald R. Boys on September 21, 2004 to request an oral election to the above restriction requirement. Donald R. Boys elected invention III, i.e., claims 25-29, without traverse.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined (37 CFR 1.143). Also, applicant is requested to cancel the non-elected claims 1-24.

#### ***Priority***

9. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged. However, the claimed steps for creating and distributing non-sensitive data summaries of claim 25, are not disclosed in the parent applications, i.e., 09/573,697 and 09/208,740; hence, applicant does not benefit the effective date as the parent priority date.

#### ***Specification***

10. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The present title is not sufficient for proper classification of the claimed subject matter.

The following title is suggested: "Extracting non-secure information from combination of secure and non-secure information".

11. The abstract is objected. The abstract should not contain terms "In preferred embodiments" and "may be". Also, the abstract should not contain claim language.

Appropriate correction is required.

#### ***Information Disclosure Statement***

12. Unless the invention is created from scratch, applicant needs to provide all the prior arts that have led to the invention, i.e., existing patents and publications related to the claimed subject matter. In response, applicant is requested to provide the title, citation and copy of each publication related to the claimed subject matter. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art. Applicant is requested to submit the prior arts used for the prosecution of the parent and copending cases.

#### ***Claim Objections***

13. Claim 26 is objected to because of the following informalities:

Claim 26 is missing "." After data-packet-network.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

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14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Neil et al. Cyva Research Corporation, 5,987,440 (Hereinafter O'Neil-Cyva).

16. As per claim 25, O'Neil-Cyva teaches a method for creating and distributing non-sensitive data summaries from data aggregated on behalf of users comprising:

(a) receiving and aggregating data on behalf of requesting users (e.g., E-Metro community collecting and aggregating individual information, abstract);

(b) de-sensitizing the aggregated data (e.g., selective decrypting of individual information, col., 6, lines 36 – 64);

(c) incorporating the de-sensitized data into the form of one or more non-sensitive data summaries (e.g., list of non-secure information for marketing firms, col., 6, lines 36 – 64);

(d) requesting the non-sensitive data summaries or summary to be delivered to an interface during a data session (e.g., users utilizing marketing firm provided information over the Internet, col., 5, line 26 - col., 6, line 6) and

(e) displaying the non-sensitive summary or summaries for user review (e.g., web browser displaying non-secure information to the user, col., 5, line 26 - col., 6, line 6).

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17. As per claim 26, O'Neil-Cyva teaches the following:  
steps (a)-(e) are practiced in conjunction with a data-packet-network (e.g., Internet network, col., 1, lines 8-10).
18. As per claim 27, O'Neil-Cyva teaches the following:  
the data-packet-network is the Internet network (e.g., Internet network, col., 1, lines 8-10).
19. As per claim 28, O'Neil-Cyva teaches the following:  
a step between (a) and (b) for identifying sensitive data portions through database comparison (e.g., selective decrypting of individual information using comparison of data of the databases, col., 16, lines 8 – 35, col., 17, line 36 – col., 18, line 12).
20. As per claim 29, O'Neil-Cyva teaches the following:  
the database used in the comparison is a user-profile database (e.g., database containing user settings information, col., 6, lines 24 – 53).

### ***Conclusion***

21. Examiner makes a very clear note that the rational of the applicant's invention has been clearly taught by O'Neil-Cyva. Applicant's invention does contain few minor additional matters that facilitate the concepts of the applicant's invention. However, the additional minor matters are well known in the art.



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22. Examiner has found numerous arts related to the disclosed subject matter. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Haresh Patel whose telephone number is 703-605-5234. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 10:00 am to 8:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 703-305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Haresh Patel

September 28, 2004

 JOHN FOLLANSBEE  
SUPERVISORY PATENT EXAMINER  
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